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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,594	05/26/2005	Seiji Iwai	NGB-38313	9213
52054	7590	03/13/2009	EXAMINER	
PEARNE & GORDON LLP			PILKINGTON, JAMES	
1801 EAST 9TH STREET				
SUITE 1200			ART UNIT	PAPER NUMBER
CLEVELAND, OH 44114-3108			3656	
			NOTIFICATION DATE	DELIVERY MODE
			03/13/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patdocket@pearne.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/536,594	IWAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	JAMES PILKINGTON	3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2009.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 2,3 and 7 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4 and 8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/09</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claim 3 now depends from claim 2 which has been previously withdrawn and therefore claim 3 is also withdrawn.

### ***Claim Objections***

2. Claim 1 line 10 objected to because of the following informalities: "the guide member" should be - - the guide portion- -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. How can the first positioning member slid without some time type of actuator. Something must act, an actuator, upon the first position member to make it move. The actuator can be anything from an electrical system to a user but there must be something to actuate the first member.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8 states that the positioning member is provided without any actuating device however the specification does not contain support for this feature. The original specification is silent with regards to an actuator. As of filling this system could have been a hydraulic or pneumatic system, there is no support in the original filing for there being no actuator.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re clm 1, the meaning of “mechanical loosening” is not understood. The specification, although providing support, does not explain what the Applicant means by “mechanical loosening.” What is “mechanical loosening”?

Re clm 8, the claim recites that the first positioning member is provided without an actuating device which allows the member be manually slid. If there is not actuating device how does the member move, there has to be some device in which at least a user operates to make the member move. As broadly defined a screw head and threads is an actuating device which a user manually manipulates to move a structure in and out of an opening. If there is no actuating structure how does the device move?

Does the Applicant mean there is no electrical, hydraulic or pneumatic actuating device? (see 35 USC 112 1<sup>st</sup> paragraph above)

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 4, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Morawski DE29717628 (cited by Applicant).

Morawski disclose an industrial robot comprising a first member (29) and a second member (13); the first member (29) including: a first mount portion (accommodating feature for 16 and 14') where a first position member (14') slides in such a manner as to protrude from a first guide portion (hole/bushing holding 14'); and the second member (13) including: an abutment portion (13 is the abutment portion) which is brought into abutment with the first positioning member (14') when the first (29) and second (13) members rotate relatively; wherein the first positioning member (14') and the guide portion (hole/bushing) adopt a socket and spigot construction which is free from mechanical loosening (as best understood Morawski does not say the device loosens and is therefore free of mechanical loosening), and where the first positioning member (14') is held at a position where the first positioning member (14') does not protrude from the first member (29, the right side of the lower assembly in Figure 2 does not protrude out of the first member relative to the wall to the right of the lower

assembly) when performing a normal operation, whereas only when performing an origin adjustment the first position member (14') is made to protrude (see assembly on right of Figure 2 showing the protruded position where 14' is extended outside of the high side of the wall)

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 8, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Morawski, DE29717628, in view of Wakita, JP2002-239967 (cited by Applicant).

Morawski discloses all of the claimed subject matter as discussed above.

Morawski does not disclose that the first member is provided with a manually actuated assembly.

Wakita teaches that a set pin (25) can be provided with a manually actuated system, in the form of a hole (28) and thread (27), i.e. a screw arrangement, for the purpose of reducing manufacturing costs (see translated abstract provided by Applicant).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Morawski and provide a manual actuating assembly

(screw system), as taught by Wakita to position the first member to yield the predictable result of providing a member that can be manually actuated to simplify the system and therefore reducing manufacturing costs.

### ***Response to Arguments***

12. Applicant's arguments, see Remarks, filed 2/06/09, with respect to Nakamura, JP4-013285 and JP02-180580 have been fully considered and are persuasive.
13. Applicant's arguments filed 2/6/09 with respect to Morawski have been fully considered but they are not persuasive.

The Applicant argues that Morawski does not show an arrangement where the first positioning member does not protrude from the first member.

Morawski does indeed show this limitation as claimed. Morawski shows a circular arrangement and the first positioning member does not protrude relative to the high side of the circle in which it is contained. The claim does not set forth any particular arrangement of the non-protruded state to differentiate from the prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/  
Examiner, Art Unit 3656  
3-4-09

/Richard WL Ridley/  
Supervisory Patent Examiner, Art Unit 3656